

ARGUMENTS

Claims 1-16 are rejected and pending. Claims 17-20 have been added. Applicant submits the Declaration of Michael A. Evans and respectfully requests reconsideration and withdrawal of all rejections.

Responsive to the rejection of claims 1-4 and 14-16 under 35 U.S.C. § 101 as being directed to non-statutory subject matter, Applicants submit the following response. The process steps stated in the claims relate to physical and tangible elements that are manipulated, either by a computer as disclosed as one embodiment in the specification, or otherwise by a professional delivering human capital management services. The act of providing a plurality of tests is physically no different than providing a plurality of widgets, and the claim recitations regarding competencies and attributes relate to the composition and administration of the tests themselves. Similarly, the act of obtaining responses involves physical, tangible steps, regardless of whether the tests are administered by computer, pencil and paper, typewriter, or other mechanism. Finally, the act of cross-referencing involves creating a comprehensive individual capability evaluation that rates the plurality of competencies.

While abstract ideas are employed in the claimed process which correlates attributes and competencies to create a tangible comprehensive individual capability evaluation, there is a tangible and concrete link between obtaining the responses to the questions and creating the evaluation that involves a new, non-obvious, and repeatable functional relationship between the responses obtained and the creation of the evaluation. The prior art documents of record show the utility of such evaluations in general, and the present invention is an improvement on such existing evaluations. As stated in the present application (paragraph 23 of the published application): "By selecting certain portions to obtain data relevant to particular aspects of Leadership Talent, its several aspects can be evaluated using validated tests and more comprehensive conclusions can be formulated from the results of the several tests than in any single Assessment Instrument. The invention realizes that a single Assessment Instrument is probably incapable of obtaining significant data on all aspects of Leadership Talent, and cross-

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references data from Assessment Instruments to obtain data relevant to such a comprehensive evaluation."

As *In re Gulack* stands for the proposition that an Examiner may not ignore expressions on the physical objects for purposes of patentability, MPEP 2106 provides favorable guidance. In fact, while *In re Ngai* stands for the proposition that merely adding instructions to an existing product does not impart patentability, even if the instructions define a patentable process; the present invention is distinguishable because the existing tests are provided and the responses cross-referenced in a novel way to create the comprehensive individual capability evaluation. The presently claimed invention is statutory because it is a process that produces a useful, tangible, and concrete result in the form of a comprehensive individual capability evaluation, such tangible result being mandated by MPEP 2106.

Responsive to the rejection of claims 1-3, 5-7, 9, and 11-13 under 35 U.S.C. 103(a) as being unpatentable over U. S. Patent Publication No. 2002/0045154) to Wood et al., ("Wood") in view of U.S. Patent Publication No. 2004/0053203 to Walters et al. ("Walters"), Applicants submit that the Evans Declaration completes the showing that Walters is not prior art to the present application.

Specifically, Evans sets forth the acts of inventorship as the Snively Declaration did, although the Evans declaration is slightly different as Evans' participation in the invention development was different than that of Snively. However, both the Snively and Evans Declarations refer to acts of inventorship in the "Hallmarks of Leadership Excellence" product development material, and the Evans Declaration specifically relates inventorship activity with claim elements from the pending claims and attaches the "Hallmarks of Leadership Excellence" document. The Snively Declaration also references the "Hallmarks of Leadership Excellence" which is attached to the Pfenninger Declaration.

Applicants respectfully submit that the Declarations of Snively, Evans, Pfenninger and Erdman evidence that Evans and Snively conceived of the claimed invention prior on or before

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August 30, 2002, diligently reduced the invention to practice in October 2002, and diligently proceeded with the filing of the present application. The Examiner is reminded of MPEP 715.07 that he "must consider all of the evidence presented in its entirety" to determine that Applicants have provided facts and documentary evidence that satisfactorily support Applicants' prior invention of that claimed in the present application.

Even if Walters were considered prior art to the present application, the invention is still patentable over the combination of Wood and Walters. Wood teaches a system that utilizes one or more instruments to measure the system user's characteristics in order to classify the person into a selected personality scheme and to match advice, content and other people with the user based upon the results of the instruments. (Paragraph 45 of Wood). The instruments provide questions to the user to obtain different types of data, including demographic data, psychographic data, personality data (including data that measures cognitive skills and competencies), life style and quality of life data, application specific data, behavioral data, declared preferences data, scenario based testing data and roll play based testing data. (Paragraphs 75 – 168 of Wood). The obtained data is then scored, standardized into alphanumeric representations and compared to personality models so that the user can be classified into a personality scheme. (Paragraph 81 of Wood).

While the personality instruments taught by Wood may be used to obtain data that measures one's skills and competencies, Wood does not disclose, teach or suggest that the instruments may be used to assess a plurality of *attributes* associated with at least one of a plurality of competencies. Combining the competencies of Woods with the testing of competencies to determine attributes by Walters as asserted by the Examiner does not address the assessment of attributes claimed in the present invention. Furthermore, the Walters instrument is used exclusively for selection and uses third party evaluators to candidates (applicants for schools, jobs, etc) with letters of recommendation and/or solicits feedback from questionnaires. The feedback mechanisms in the Walters invention are so varied that a standardized instrument approach could not be identified as compared to the presently claimed

invention that uses multiple capability testing instruments. The Walters invention solicits feedback from third party evaluators to select applicants. In contrast, the present invention administers its evaluation to the respondent and cross-references the resulting assessment data to provide a comprehensive individual capability evaluation.

The Wood teaching of multiple tests being "USED IN CONJUNCTION" does not disclose, teach, or suggest the present invention's cross-referencing responses of multiple tests by attributes. In Woods, there is no explicit disclosure regarding "USED IN CONJUNCTION" and the dictionary definition of this term only speaks of using multiple tests together. Contrast Woods with the present invention, disclosing and claiming cross-referencing wherein the dictionary definition of cross-references is "a notation or direction at one place to pertinent information at another place." (See Exhibit A to this Amendment including such definitions from Webster's dictionary). Applicants submit that Wood does not include having references from attributes directed to pertinent information at another place on the multiple tests, and therefore Wood does not disclose, teach, nor suggest the cross-referencing of the present invention.

Responsive to the rejection of claims 4, 8, 10 and 14-16 under 35 U.S.C. 103(a) as being unpatentable over Wood in view of Walters and further in view of U.S. Patent No. 6,341,267 to Taub ("Taub"), Taub adds no further teaching or suggestion regarding the cross-referencing of attribute assessments in creating comprehensive individual capability evaluations. Therefore, Applicants submit that for the reasons stated above relating to the rejection based on Wood and Walters, this rejection has also been traversed.

Responsive to the rejection of claims 1-3, 5-7, 9, and 11-13 under 35 U.S.C. 103(a) as being unpatentable over Wood in view of Bonnstetter, Applicants submit that Bonnstetter adds no further teaching or suggestion relating to a plurality of questions used to assess attributes associated with competencies.

Bonnstetter discloses a system for analyzing individual competencies for matches with potential jobs. Bonnstetter discloses 23 competencies, each of which is the subject of 9 questions, with the answers to the 9 questions enabling the system to rate the particular competency. Bonnstetter lacks any disclosure, teaching, or suggestion of having a plurality of tests relating to attributes of competencies, and cross-referencing responses in relation to the attributes.

The present invention enables the evaluation of the components of competencies, the constituent attributes, so that relevant attributes may be addressed and the individuals evaluated may be trained in areas to improve those attributes. This allows for individuals to focus on attribute areas, for example those identified in a comprehensive individual capability evaluation, to raise an individual's competencies. In Bonnstetter, an individual is only rated on the gross competency evaluation, with no insight on the component attributes. Thus, the cited prior art references, along or in combination, fail to disclose, teach, or suggest the claimed invention.

Responsive to the rejection of claims 4, 8, 10 and 14-16 under 35 U.S.C. 103(a) as being unpatentable over Wood in view of Bonnstetter and further in view of Taub, Taub adds no further teaching or suggestion regarding the cross-referencing of attribute assessments in creating comprehensive individual capability evaluations. Therefor, Applicants submit that for the reasons stated above relating to the rejection based on Wood and Bonnstetter, this rejection has also been traversed.

Furthermore, none of the cited prior art references disclose, teach or suggest the further refinement wherein cross-referencing is done by competencies as they relate to the responses relating to a particular attribute to create a comprehensive individual capability evaluation relating to those attributes, as more particularly called out in new claims 17-20.

For all of the above reasons, Applicants submit that claims 1-20 **are in allowable form** thereby placing the application in condition for allowance. Applicants respectfully request allowance thereof.

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Should any questions concerning any of the foregoing arise, Examiner is invited to telephone the undersigned at (317) 237-0300.

In the event that Applicants have overlooked the need for an extension of time or a payment of fee, Applicants hereby conditionally petition therefore and authorize that any charges be made to Deposit Account No. 02-0390, BAKER & DANIELS.

Respectfully submitted,

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